

## **General Analysis for Determining Patent-Eligible Subject Matter**

Training on the guidelines is being developed and will be offered soon. In the mean time, here is the general process:

The first step is to determine whether the claim falls into one of the four statutory categories of invention. Note that if the claim is directed to a computer or machine readable medium, the medium is considered a manufacture unless there is evidence in Applicant's spec that they intend for it to cover signals, waves, etc (see Annex IV of the Interim Guidelines) or non-functional descriptive material (e.g., a piece of paper with the instructions written on it).

Next, determine whether the claim is directed to a judicial exception (law of nature, natural phenomena, or an abstract idea) which would make it non-statutory if it is directed to the exception itself, rather than a practical application of the exception.

One way a practical application can be established is through claiming a physical transformation (data transformation is not a physical transformation and is not, in and of itself, evidence of statutory subject matter).

Where there is no physical transformation being claimed, a practical application would be established by a useful, concrete and tangible result. That result is useful if it has specific, substantial and credible utility. Make a determination whether such is the case based on the perspective of one of ordinary skill having read the claim in light of the disclosure. It's concrete if it produces an assured, repeatable result (e.g., same input produces the same output each time the steps are performed). For it to be a tangible result, it must be more than just a thought or a computation. Instead, it must have real world value rather than being an abstract result.

One issue for computer related products is whether functional descriptive material is being claimed (e.g., code or instructions or a data structure (the IEEE definition of which can be found in the Interim Guidelines, Annex IV, page 50, and in MPEP 2106) or merely non-functional descriptive material (e.g., data or non-functional arrangements of data). In either instance, claiming just the functional or non-functional descriptive material absent being claimed in combination with an appropriate medium to establish a statutory category of invention and enable any functionality to be realized is non-statutory. Non-functional descriptive material is non-statutory even when claimed as stored on an otherwise appropriate medium.

If you think you have a case where preemption applies, ask the 101 Help Panel members for additional help.

Note that whether a method includes "computer-implemented" or not, whether the word "tangible" has been inserted before medium or whether the steps could be performed using, e.g., pencil and paper, are all currently IMMATERIAL to making a determination as to whether the subject matter is patent-eligible. Likewise, for a system or an apparatus or a machine to be a physical object, at least one recited element must be hardware. If all elements would have been reasonably interpreted in light of the disclosure by one of ordinary skill as software alone, the claim is directed to software per se and is non-statutory. If applicant has invoked 112, 6th, by using means plus function elements, you MUST review the spec to determine what the reasonable interpretation of the means is.

If you have questions about applying the above guidance to a particular case, please feel free to e-mail your questions to the "101 Help Panel" mailbox.

**NOTE: The Interim Guidelines set forth the Official USPTO Policy.**

This is meant to be nothing more than an aid for applying the guidelines and for developing questions when asking for help from the 101 Help Panel.